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| 10/697,374 | 10/30/2003 | W. Bradley Wilkes | 15790.2 | 7893 |
| <div>7590 07/24/2008</div> <div>R. BURNS ISRAELSEN WORKMAN NYDEGGER 1000 Eagle Gate Tower 60 East South Temple Salt Lake City, UT 84111</div> <div>EXAMINER GREENE, DANIEL LAWSON</div> <div>ART UNIT PAPER NUMBER</div> <div>3694</div> <div>MAIL DATE DELIVERY MODE</div> <div>07/24/2008 PAPER</div> | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/697,374

Applicant(s)

WILKES ET AL.

Examiner

DANIEL L. GREENE

Art Unit

3694

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 13, 14 and 22-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-12 and 15-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date 1/16/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Invention II (claims 9-21), species A (claim 12) in the reply filed on 4/21/2008 is acknowledged. The traversal is on the ground(s) that searching all claims in one application does not represent a "serious burden". This is not found persuasive because as set forth in the 3/21/2008 requirement for restriction the inventions require a different field of search including different search terms and strategies which does indeed present a serious burden to the Examiner. As stated in section 22 of said requirement, if applicant would **clearly admit** on the record that the inventions and species are obvious variants, then the requirement would be reconsidered. Applicant alludes on page 9 of 10, first paragraph of the 4/21/2008 response that the inventions "are sufficiently close in subject matter that searching...does not represent a serious burden", however this is not considered a clear admission. Accordingly the requirement is still deemed proper and is therefore made FINAL.
2. Claims 1-8, 13, 14, and 22-34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 4/18/2008.
3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

4. An action on the merits of 9-12 and 15-21 follows.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.


6. **Claims 9-12 and 15-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 9 is vague, indefinite and incomplete in what all is meant by and encompassed by the limitation “ambiguous” because said limitation has no particular meaning per se.

According to the definition of the term ambiguous retrieved from the internet (reproduced below) the metes and bounds of the claim are undefined as the term has no clear meaning.

For purposes of examination the term ambiguous has been disregarded as it adds no physical limitation to the term “transaction device”. It is considered that the term “transaction device” is generic to any and all “devices” capable of performing a “transaction” and therefore inherently embodies the term “ambiguous” because it is generic to all transaction devices. Again, the term ambiguous does not further limit the claim.

Dictionary.com Unabridged (v 1.1) - Cite This Source - Share This

am·big·u·ous  Audio Help æm'bigyu əs - Show Spelled Pronunciation[æm-big-yoo-uhs]
Pronunciation Key - Show IPA Pronunciation

-adjective

Art Unit: 3694

1. open to or having several possible meanings or interpretations; equivocal: *an ambiguous answer.*
2. *Linguistics.* (of an expression) exhibiting constructional homonymity; having two or more structural descriptions, as the sequence *Flying planes can be dangerous.*
3. of doubtful or uncertain nature; difficult to comprehend, distinguish, or classify: *a rock of ambiguous character.*
4. lacking clearness or definiteness; obscure; indistinct: *an ambiguous shape; an ambiguous future.*

[Origin: 1520-30; < L *ambiguus*, equiv. to *ambigere*] be uncertain (*amb-* ~~AMBI-~~ + *-igere* comb. form of *agere* to drive, lead, act) + *-uus* deverbial adj. suffix; see ~~-OUS~~]

---Related forms

am·big·u·ous·ly, *adverb*

am·big·u·ous·ness, *noun*

---Synonyms 1. AMBIGUOUS, EQUIVOCAL, CRYPTIC, ENIGMATIC describe conditions or statements not clear in meaning. AMBIGUOUS can refer to a statement, act, or attitude that is capable of two or more often contradictory interpretations, usually accidentally or unintentionally so: *an ambiguous passage in the preamble.* EQUIVOCAL, usually applied to spoken as well as written language, also means susceptible of two or more interpretations, and it usually suggests a deliberate intent to mislead by avoiding clarity: *saving face with an equivocal response to an embarrassing question.* CRYPTIC usually refers to intentional obscurity, especially in language, and often implies a private or hidden meaning but stresses resultant mystification or puzzlement: *a cryptic remark that left us struggling to interpret his intention.* ENIGMATIC focuses on perplexity resulting from a mysterious or imponderable event or utterance, often one of great importance or deep significance: *prophetic texts so enigmatic that their meaning has been disputed for centuries.* 3. dubious, vague, indeterminate, unclassifiable, anomalous. 4. puzzling, enigmatic, problematic.

---Antonyms 1. explicit. 3. certain. 4. clear, precise, unambiguous.

Dictionary.com Unabridged (v 1.1)

Based on the Random House Unabridged Dictionary, © Random House, Inc., 2006.

Claims 10-12 and 15-21 are rejected for at least being dependent on a rejected base claim.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. **Claims 9-12 and 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art (APA) in view of case law.**

Claim 9 is clearly disclosed on pages 1-4 of the specification as filed. Said pages clearly disclose a method for conducting an electronic financial transaction over a

network using a transaction device, the method comprising (see for example, paragraph [003]):

receiving an electronic financial transaction request from the transaction device over the network, the transaction request including merchant identifying information (see for example, paragraphs [005]-[008].;

accessing a merchant account database having information specifying a plurality of merchant accounts, each of the plurality of merchant accounts having merchant identifying information associated therewith (see for example, paragraph [008]); and

associating the transaction with one of the plurality of merchant accounts by comparing the merchant identifying information received in the transaction request with the merchant identifying information associated with each of the plurality of merchant accounts in the merchant account database (see for example, paragraph [005].

APA does not appear to explicitly disclose that the merchant information is stored separately from the transaction device and transaction data.

Resort may be had to at least the following three case law citations to show that there is no novelty in merely rearranging the parts of a known system when the end result is the same. That is, the financial transactions are carried out as long as the required information is received. It is immaterial where or how this information stored or transmitted as long as it is present.

See *In re Venner*, 120 USPQ 192 (CCPA 1958), *In re Smith*, 73 USPQ 394

“If a new combination of old elements is to be patentable, the elements must cooperate in such manner as to produce a new, unobvious, and unexpected result. It must amount to an invention”,

In re Dulberg, 129 USPQ 348, (CCPA 1961)

“It has been held that constructing a formerly integral structure in various elements involves only routine skill in the art“

In re Lindberg, 93 USPQ 23 (CCPA)

“It is not regarded as inventive to merely make an old device portable or movable without producing any new and unexpected result”

At the time of the invention it would have been obvious to one of ordinary skill in the art to have the merchant information stored separately from the transaction device and transaction data as such involves only “routine skill in the art” and does not produce any new or unexpected result. It would have also been obvious to do so for the benefit of additional security, because if the transaction device is stolen it cannot be used to make fraudulent charges since it has no merchant information stored therein.

Regarding claim 10 and the limitation, wherein the transaction device receives the merchant identifying information and the transaction information on a per transaction basis, one must appreciate that if the transaction device does not have merchant identifying information then the transaction cannot be consummated. Accordingly said information is required and must accompany each transaction, see for example, paragraph [008] of the specification as filed.

Regarding claim 11 and the limitation wherein the merchant identifying information is stored separately on a transaction storage device and the transaction device receives the merchant identifying information from the transaction storage device to generate the transaction request, again the merchant identifying information must accompany the

transaction request. According to paragraph [008] of the specification as filed "the merchant's account information is programmed into the point of sale device.". The term "programmed" is synonymous with the term "stored". In the computer art this programming and storing is usually done in a computer buffer or memory of some sort (either resident or removable).

Accordingly it would have been obvious to one of ordinary skill in the art to store merchant identifying information on a transaction storage device for the purposes set forth above in the rejection of claim 9.

Regarding claim 12 and the limitation wherein the transaction storage device is a financial card, resort may be had to paragraphs [005] and [008] of the specification as filed to show that it is known in the art for financial cards to be "encoded with transaction data" and accordingly it would be obvious to do such.

Regarding claims 15-17 and the limitations, wherein the transaction device is a cellular telephone, a computer, a point of sale terminal and an automatic teller machine, see for example, paragraph [007] wherein applicant admits that many different point of sale terminals have been developed. All of these transaction devices are art level equivalents and as such it would be obvious to utilize any and all of them to effectuate the financial transaction as the end result remains the same, i.e. the transaction is consummated.

Regarding claim 18 and the limitation, wherein at least some of the transaction data is generated by the transaction device upon selection of a menu item from a menu on the device.

Regarding claims 19 and 20 and the limitations, wherein the ambiguous device generates at least some of the transaction data by receiving said at least some of the transaction data from a card reader and the transaction data comprises a credit card number, a credit card expiration date, and an amount, see for example, paragraph [006] “input through a card reader”, paragraph [008] wherein it is disclosed that such practice is “typical”, etc.

Regarding claim 21 and the limitation, wherein a plurality of external devices communicate with the ambiguous device through a wireless connection, each of the external devices being capable of transmitting merchant identifying information and transaction data to the ambiguous device through the wireless connection, again see for example, paragraph [007] to show that wireless operation of transaction devices is well known and paragraph [006] to show that transaction devices are “encoded with the merchant’s account information”. There is no novelty in HOW the device is encoded or HOW it receives information as long as the financial transaction is consummated. Further, claim 21 does not appear to further limit the METHOD of claim 9 as it appears directed to structure which is “capable” of transmitting information. See, *Ex parte Pfeiffer*, 135 USPQ 31 (BdPatApp&Int 1961)

“As to the rejection of the claims on the prior art references, we do not agree with the appellant that such structural limitations as are not disclosed by the references should be given patentable weight. This argument is applicable to claims drawn to structure and not claims drawn to a method. To be entitled to such weight in method claims, the recited structural limitations therein must affect the method in a manipulative sense and not to amount to the mere claiming of a use of a particular structure, which, in our opinion, is the case here.”

10. Claims 9-12 and 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2002/004772 A1 to Templeton et al. in view of case law.

Templeton et al discloses claim 9, i.e. a method for conducting an electronic financial transaction over a network using a transaction device, the method comprising:

receiving an electronic financial transaction request from the ambiguous transaction device over the network, the transaction request including merchant identifying information,

accessing a merchant account database having information specifying a plurality of merchant accounts, each of the plurality of merchant accounts having merchant identifying information associated therewith; and

associating the transaction with one of the plurality of merchant accounts by comparing the merchant identifying information received in the transaction request with the merchant identifying information associated with each of the plurality of merchant accounts in the merchant account database.

Although Templeton et al discloses that the method can be implemented by many different hardware and software configurations, Templeton does not appear to explicitly disclose that the merchant information is stored separately from the transaction device and transaction data.

Resort may be had to at least the following three case law citations to show that there is no novelty in merely rearranging the parts of a known system when the end result is the same. That is, the financial transactions are carried out as long as the required

information is received. It is immaterial where or how this information stored or transmitted as long as it is present.

See *In re Venner*, 120 USPQ 192 (CCPA 1958), *In re Smith*, 73 USPQ 394

“If a new combination of old elements is to be patentable, the elements must cooperate in such manner as to produce a new, unobvious, and unexpected result. It must amount to an invention”,

In re Dulberg, 129 USPQ 348, (CCPA 1961)

“It has been held that constructing a formerly integral structure in various elements involves only routine skill in the art”

In re Lindberg, 93 USPQ 23 (CCPA)

“It is not regarded as inventive to merely make an old device portable or movable without producing any new and unexpected result”

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify the transaction devices of Templeton et al to have the merchant information stored separately from said transaction device and transaction data as such involves only “routine skill in the art” and does not produce any new or unexpected result. It would have also been obvious to do so for the benefit of additional security, because if the transaction device is stolen it cannot be used to make fraudulent charges since it has no merchant information stored therein.

Regarding claim 10 and the limitation wherein the ambiguous transaction device receives the merchant identifying information and the transaction information on a per transaction basis, one must appreciate that without said information being present the transaction will not complete, that is, said information is required and inherently included within each individual transaction..

Regarding claim 11 and the limitation wherein the merchant identifying information is stored separately on a transaction storage device and the ambiguous transaction device receives the merchant identifying information from the transaction storage device to generate the transaction request, see for example, the rejection of base claim 9 above wherein it is understood that in order for a transaction to be consummated it must have the appropriate information. Without such information the transaction fails.

Regarding claim 12 and the limitation wherein the transaction storage device is a financial card, see for example, paragraph [0005]..

Regarding claims 15-17 and the limitations, wherein the transaction device is a cellular telephone, a computer, a point of sale terminal and an automatic teller machine, see for example, paragraph [0011] wherein Templeton et al. clearly states that the invention is applicable to ANT system capable of performing the intended transactions. All of these transaction devices are art level equivalents and as such it would be obvious to utilize any and all of them to effectuate the financial transaction as the end result remains the same, i.e. the transaction is consummated.

Regarding claim 18 and the limitation wherein at least some of the transaction data is generated by the transaction device upon selection of a menu item from a menu on the ambiguous device see for example, paragraph [0028] wherein it is understood that the use of a menu for selection of a choice is notoriously old and well known and would be an obvious thing to use for said selection.

Regarding claims 19 and 20 and the limitations wherein the ambiguous device generates at least some of the transaction data by receiving said at least some of the transaction data

from a card reader and the transaction data comprises a credit card number, a credit card expiration date, and an amount, see for example, paragraph [0005] etc.

Regarding claim 21 and the limitation wherein a plurality of external devices communicate with the ambiguous device through a wireless connection, each of the external devices being capable of transmitting merchant identifying information and transaction data to the ambiguous device through the wireless connection, see for example, paragraph [0011] etc. wherein a plurality of devices are set forth all capable of transmitting information to and from each other.

Conclusion

11. Examiner's Note: The Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL L. GREENE whose telephone number is (571)272-6876. The examiner can normally be reached on Mon-Thur.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3694

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. L. G./
Examiner, Art Unit 3694
2008-07-21

/Mary Cheung/
Primary Examiner, Art Unit 3694